

REMARKS

Claims 1-47 were pending in this application. Claims 1-5, 9-11, 22-24, and 40-42 have been amended. No claims have been added or canceled. Hence, claims 1-47 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-47 stand rejected under 35 U.S.C. § 101.

Claims 9-11, 22-24, and 40-42 stand rejected under 35 U.S.C. § 112.

Claims 1-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,903,830 to Joao *et al.* (hereinafter Joao).

Claims 1-5, 9-11, 22-24, and 40-42 have been amended to more particularly point out and distinctly claims the subject matter which the Applicants regard as their invention. The amendments are believed to add no new matter.

Claim rejections under 35 U.S.C. § 101

Claims 1-47 were rejected as being unpatentable under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Applicants respectfully traverse the rejections for the following reasons. With respect to amended claim 1, the Applicants point out that the claim recites a computer-related process because the preamble recites a “method of using a computer to monitor financial transactions.” The Applicants note that

[t]o be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan..., or (B) be limited to a practical application within the technological arts....

(MPEP § 2106 IV. B. 2. (b), (citing *Diamond v. Diehr*, 450 U.S. at 183-84)). The computer-related process of claim 1 results in a physical transformation outside the computer because it includes “transmitting an alert to a recipient.” Further, the practical application of the alert is disclosed in the specification and/or would have been known to a skilled artisan. Thus, claim 1 is directed to statutory subject matter. Claims 2-12

depend from claim 1. These claims, therefore, also are directed to statutory subject matter.

Claim 13 also recites a computer-related process because a processing server is a computing device. Further, the claim includes transmitting a notification, which results in a physical transformation outside the computer. The practical application of the notification is disclosed in the specification and/or would have been known to a skilled artisan. Thus, claim 13, and claims 14-27 which depend from it, is directed to statutory subject matter.

Claim 28 also recites a computer-related process resulting in a physical transformation outside the computer. The process includes receiving information from a processing server and transmitting an alert to the processing server. The alert is a physical transformation outside the computer, and the practical application of the alert is disclosed in the specification and/or would have been known to a skilled artisan. Thus, claim 28, and claims 29 and 30 which depend from it, are directed to statutory subject matter.

Claims 31-47 recite physical structure defining a useful machine in terms of its hardware or hardware and software combinations, which defines a statutory product. (See, *e.g.*, Lowry, 32 F.3d at 1583, 32 USPQ2d at 1034-35).

Claim rejections under 35 U.S.C. § 112

Claims 9-11, 22-24, and 40-42 were rejected under 35 U.S.C. § 112 because “the phrase ‘about’ renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.” The claims have been amended to remove “about” and are now believed to be allowable with respect to 35 U.S.C. § 112.

Claims rejections under 35 U.S.C. § 103(a)

Claims 1-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao. However, the Applicants respectfully traverse the rejection of each claim

because the Applicants believe the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria.

For example, with respect to claim 1, Joao does not teach or suggest “periodically receiving a target account identifier of a suspect account [and]... comparing the target account identifier with ... transaction information to determine if the target account identifier matches any of the account identifiers of the transaction information.” Thus, the prior art does not teach or suggest all the claim limitations. Further, the office action states that it would have been obvious to modify Joao to achieve the Applicants’ claimed invention; however, the office action does not cite any motivation or suggestion in the prior art to do so. The office action appears to rely on facts within the personal knowledge of the Examiner to provide the motivation. Thus, the Applicants respectfully traverse the rejection. Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added) Because no reference is cited providing the teaching, suggestion, or motivation to modify Joao, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03.

Because the office action does not cite references that teach or suggest all the limitations of claim 1, and because the office action does not cite a suggestion or motivation in the prior art to modify Joao to achieve the Applicants' claimed invention, the Applicants believe claim 1 is allowable, at least for these reasons. Further, claims 2-12, which depend from claim 1, are believed to be allowable, at least for the reasons stated above with respect to claim 1.

With respect to claim 13, Joao does not teach or suggest "receiving a list having a plurality of target account identifiers ... [and] transmitting at least a portion of the list to one or more platform servers ... configured to ... search ... transaction information for transaction records having a target account identifier from the list." Further, no motivation or suggestion to modify Joao is cited from the prior art. The Applicants assume the office action is once again relying on facts within the personal knowledge of the Examiner. Thus, the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03.

Because the office action does not cite references that teach or suggest all the limitations of claim 13, and because the office action does not cite a suggestion or motivation in the prior art to modify Joao to achieve the Applicants' claimed invention,

the Applicants believe claim 13 is allowable, at least for these reasons. Further, claims 14-27, which depend from claim 13, are believed to be allowable, at least for the reasons stated above with respect to claim 13.

With respect to claim 28, Joao does not teach or suggest "receiving ... a list having at least a target account identifier [and] searching ... transaction information for transaction records having a target account identifier from the list." Further, no motivation or suggestion to modify Joao is cited from the prior art. The Applicants assume the office action is once again relying on facts within the personal knowledge of the Examiner. Thus, the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03.

Because the office action does not cite references that teach or suggest all the limitations of claim 28, and because the office action does not cite a suggestion or motivation in the prior art to modify Joao to achieve the Applicants' claimed invention, the Applicants believe claim 28 is allowable, at least for these reasons. Further, claims 29 and 30, which depend from claim 28, are believed to be allowable, at least for the reasons stated above with respect to claim 28.

Independent claims 31, 45, and 47 include limitations similar to those discussed above with respect to claims 1, 13, and 28, which are not taught or suggested by Joao. Further, the Applicants assume the office action is once again relying on facts within the personal knowledge of the Examiner for the motivation to modify the prior art to achieve the Applicants' claimed invention. Thus, the Applicants respectfully traverse the rejections and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by MPEP § 2144.03.

Because the office action does not cite references that teach or suggest all the limitations of claims 31, 45, and 47, and because the office action does not cite a suggestion or motivation in the prior art to modify Joao to achieve the Applicants' claimed invention, the Applicants believe claims 31, 45, and 47 are allowable, at least for

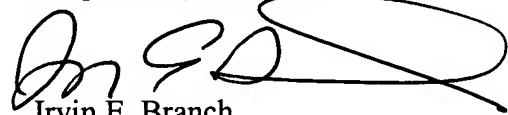
these reasons. Further, claims 32-44, which depend from claim 31, and claim 46, which depends from claim 45, are believed to be allowable, at least for the reasons stated above with respect to claims 31 and 45, respectively.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Amended) A method of **monitoring** using a computer to  
monitor financial transactions, the method comprising:  
periodically receiving a target account identifier of a suspect account;  
receiving financial transaction information, the financial transaction  
information including transaction records for a plurality of financial transactions that  
each have at least one associated account identifier;  
comparing the target account identifier with the transaction information to  
determine if the target account identifier matches any of the account identifiers of the  
transaction information; ~~and~~  
upon the occurrence of a match, generating an alert having at least a  
portion of the transaction record that has an account identifier matching the target  
account identifier; and  
transmitting the alert to a recipient.
2. (Amended) The method as in claim 1, ~~further comprising~~  
~~electronically transmitting the alert to~~ wherein the recipient comprises a provider of  
the target account identifier.
3. (Amended) The method as in claim 1, ~~further comprising~~  
~~electronically transmitting the alert to~~ wherein the recipient comprises an owner of the  
suspect account.
4. (Amended) The method as in claim 1, ~~further comprising~~  
~~electronically transmitting the alert to~~ wherein the recipient comprises a designee of a  
provider of the target account.

5. (Amended) The method as in claim 1, ~~further comprising electronically transmitting the alert to~~ wherein the recipient comprises a compiler of marketing information relating to the account.

6. (As Filed) The method of claim 5, wherein the marketing information includes the spending habits of a user of the suspect account.

7. (As Filed) The method as in claim 1, wherein the target account identifier comprises a suspect credit card number.

8. (As Filed) The method as in claim 1, wherein the transaction records further include transaction location, data of transaction, time of transaction and account holder name.

9. (Amended) The method as in claim ~~2~~1, wherein the comparing and transmitting steps are performed within ~~about~~ 15 minutes from the time that a transaction record having an account identifier matching the target account identifier is received.

10. (Amended) The method as in claim ~~2~~1, wherein the comparing and transmitting steps are performed within ~~about~~ 5 minutes from the time that a transaction record having an account identifier matching the target account identifier is received.

11. (Amended) The method as in claim ~~2~~1, wherein the comparing and transmitting steps are performed within ~~about~~ 1 minute from the time that a transaction record having an account identifier matching the target account identifier is received.

12. (As Filed) The method as in claim 1, wherein generating the alert includes processing electronic data into an electronic textual message representing at least a portion of the content of the electronic data.



13. (As Filed) A method of monitoring financial transactions, comprising:

at a processing server, periodically receiving a list having a plurality of target account identifiers;

periodically transmitting at least a portion of the list to one or more platform servers, wherein the one or more platform servers are each configured to receive transaction information, the transaction information including transaction records of financial transactions, the transaction records including account identifiers used in the transactions, and wherein the one or more platform servers are configured to search the transaction information for transaction records having a target account identifier from the list;

at the processing server, receiving from a platform server an alert that the platform server has identified a transaction record having a target account identifier, the alert including transaction data from the transaction record; and

transmitting from the processing server a notification based on the alert that a target account identifier has been identified in a transaction record.

14. (As Filed) The method of claim 13, wherein the list comprises an electronic file from a government agency.

15. (As Filed) The method of claim 13, wherein the list is received by the processing server at least daily.

16. (As Filed) The method of claim 13, wherein the list is requested by at least one platform server at least daily.

17. (As Filed) The method of claim 13, further comprising, upon receipt of the list at the processing server, transmitting from the processing server a list available message to at least one platform server indicating that the processing server has

received the list, in response to which at least one platform server transmits a request to the processing server to send the list.

18. (As Filed) The method of claim 13, further comprising transmitting the list from the processing server to at least one platform computer upon receipt of the list by the processing server.

19. (As Filed) The method of claim 13, wherein the notification is transmitted by email.

20. (As Filed) The method of claim 13, wherein the notification is transmitted to a personal computer.

21. (As Filed) The method of claim 20, wherein the personal computer is selected from the group consisting of mobile phone, personal pager, and personal digital assistant.

22. (Amended) The method of claim 13, wherein the notification is transmitted within ~~about~~ 15 minutes from the time that the alert is received.

23. (Amended) The method of claim 13, wherein the notification is transmitted within ~~about~~ 5 minutes from the time that the alert is received.

24. (Amended) The method of claim 13, wherein the notification is transmitted within ~~about~~ 1 minutes from the time that the alert is received.

25. (As Filed) The method of claim 13, wherein the transaction record includes, date of usage, time of usage and location of usage.

26. (As Filed) The method of claim 13, wherein the notification includes the account identifier, the data the identifier was used, the time the account identifier was used, and the address where the account identifier was used.

27. (As Filed) The method of claim 13, further comprising processing the alert at the processing server by combining transaction data from the alert with stored transaction data relating to the target account identifier, and wherein the notification is based on the alert and the stored transaction data.

28. (As Filed) A method of monitoring financial transactions, comprising:

receiving from a processing server a list having at least a target account identifier;

receiving transaction information, the transaction information including transaction records of financial transactions, the transaction records including account identifiers used in the transactions;

searching the transaction information for transaction records having a target account identifier from the list;

upon the occurrence of a match, generating an alert having at least a portion of the transaction record that has an account identifier matching a target account identifier; and

transmitting the alert to the processing server.

29. (As Filed) The method of claim 28, further comprising requesting the list from the processing server.

30. (As Filed) The method as in claim 28, wherein generating the alert includes processing electronic data into an electronic textual message representing at least a portion of the content of the electronic data.

31. (As Filed) A system for monitoring financial transactions, comprising:

a processing server; and

at least one platform server in electronic communication with the processing server;

wherein the processing server is configured to receive a list of target account identifiers and transmit the list to the at least one platform server, wherein the at least one platform server is configured to receive the list of target account identifiers, wherein the at least one platform server is further configured to receive transaction information, including transaction records of financial transactions having account identifiers used in the transactions, wherein the at least one platform server is further configured to compare the account identifiers in the transaction records to target account identifiers on the list, wherein, upon the occurrence of a match between a target account identifier and an account identifier in a transaction record, the at least one platform server is configured to produce an alert and transmit the alert to the processing server, wherein the processing server is configured to produce a notification based on the alert and transmit the notification to a personal computer.

32. (As Filed) The system of claim 31, wherein the list comprises an electronic file from a federal agency.

33. (As Filed) The system of claim 31, wherein the list is received by the processing server at least daily.

34. (As Filed) The system of claim 31, wherein the list is requested by at least one platform server at least daily.

35. (As Filed) The system of claim 31, further comprising, upon receipt of the list at the processing server, transmitting from the processing server a list available message to at least one platform server indicating that the processing server has received a list, in response to which the at least one platform server transmits a request to the processing server to send the list.

36. (As Filed) The system of claim 31, further comprising transmitting the list from the processing server to at least one platform server upon receipt of the list by the processing server.

37. (As Filed) The system of claim 31, wherein the notification is transmitted by email.

38. (As Filed) The system of claim 31, wherein the notification is transmitted to a personal computer.

39. (As Filed) The system of claim 31, wherein the personal computer is selected from the group consisting of mobile phone, personal pager, and personal digital assistant.

40. (Amended) The system of claim 31, wherein the notification is transmitted from the processing server within ~~about~~ 15 minutes from the time the processing server receives the alert.

41. (Amended) The system of claim 31, wherein the notification is transmitted from the processing server within ~~about~~ 5 minutes from the time the processing server receives the alert.

42. (Amended) The system of claim 31, wherein the notification is transmitted from the processing server within ~~about~~ 1 minutes from the time the processing server receives the alert.

43. (As Filed) The system of claim 31, wherein the transaction record includes, date of usage, time of usage and location of usage.

44. (As Filed) The system of claim 31, wherein the notification includes the account identifier, the data the identifier was used, the time the account identifier was used, and the address where the account identifier was used.

45. (As Filed) A system for monitoring financial transactions, comprising:

a processing server; and

a communications arrangement associated with the processing server, the communications arrangement being configured to facilitate electronic communication between the processing server and at least a platform server;

wherein the processing server is configured to receive a list of target account identifiers and transmit the list to a platform server, wherein a platform server is configured to receive the list of target account identifiers, wherein a platform server is further configured to receive transaction information, including transaction records of financial transactions having account identifiers used in the transactions, wherein a platform server is further configured to compare the account identifiers in the transaction records to target account identifiers on the list, wherein, upon the occurrence of a match between a target account identifier and an account identifier in a transaction record, a platform server is configured to produce an alert and transmit the alert to the processing server, wherein the processing server is configured to produce a notification based on the alert and transmit the notification to a personal computer.

46. (As Filed) The system of claim 45, wherein the personal computer is selected from the group consisting of mobile phone, personal pager, and personal digital assistant.

47. (As Filed) A system for monitoring financial transactions, comprising:

a platform server; and

a communications arrangement associated with the platform server, the communications arrangement being configured to facilitate electronic communication between the platform server and a processing server;

wherein the processing server is configured to receive a list of target account identifiers and transmit the list to the platform server, wherein the platform

server is configured to receive the list of target account identifiers, wherein the platform server is further configured to receive transaction information, including transaction records of financial transactions having account identifiers used in the transactions, wherein the platform server is further configured to compare the account identifiers in the transaction records to target account identifiers on the list, wherein, upon the occurrence of a match between a target account identifier and an account identifier in a transaction record, the platform server is configured to produce an alert and transmit the alert to the processing server, wherein the processing server is configured to produce a notification based on the alert and transmit the notification to a personal computer